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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/530,308 | 09/05/2000 | Shih-fu Chang | A31358-PCT | 5406 |
| 21003 | 7590 | 02/09/2005 | EXAMINER | |
| BAKER & BOTTS 30 ROCKEFELLER PLAZA NEW YORK, NY 10112 | | | DESIR, JEAN WICEL | |
| | | ART UNIT | | PAPER NUMBER |
| | | | | 2614 |

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/530,308 | CHANG ET AL. | |
| Examiner | | Art Unit | |
| Jean W. Désir | | 2614 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 27 September 2004, RESPONSE.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-5 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-4 is/are rejected.

7) Claim(s) 5 is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Braudaway et al (US 5,530,759).

Claim 1:

Braudaway discloses:

“obtaining digital data of a transformed representation of the image”, see Fig. 2 item 202;

“determining a transformed representation of the watermark for optimized visibility of the watermark in the image”, see Fig. 2 items 206, 214, ABSTRACT lines 1-3;

“and superposing the transformed representation of the watermark on the transformed representation of the image”, see Fig. 2 items 214, 215, ABSTRACT lines 1-3.

Claim 4 is inherent to Braudaway’s disclosure.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2, 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Braudaway et al (US 5,530,759).

Claim 2:

Braudaway does not explicitly disclose that the transformed representation of the image is a compressed representation as claimed in claim 2. However, compression is very well known coding technique in the art that would reduce transmission or storage requirements; thus, an artisan would be motivated to implement this technique in Braudaway's system, because this implementation would reduce transmission or storage requirements. Therefore, the claimed invention would have been obvious to a person of ordinary skill in the art at the time the invention was made.

Claim 3 is rejected for the same reasons as claim 2, the DCT is a well known transformed representation that has a strong energy compaction property.

Response to Arguments

5. Applicant's arguments have been fully considered but they are persuasive.

Applicants argue on pages 3-5 of the REMARKS that "Braudaway is directed to watermarking of still images, without any mention of or concern for video images, which

are a important consideration for the claimed invention. As noted in the specification of the present application, the claimed features relate to one of the objects of the invention, i.e., to keep a watermark sufficiently visible throughout a video sequence, wherein the image changes from frame to frame. (Specification, p. 3, lines 13-21)". These arguments are not persuasive, because, even though Braudaway cited as example of images: painting or photograph, Braudaway is not limited to still images as argued by the Applicants; in fact, Braudaway clearly pointed out that "many other types of images also exist" (see col. 4 lines 1-2), and, in col. 4 lines 49-51, Braudaway also pointed out "that there are many other system configurations in which the present invention could be employed; thus, the Braudaway's system is not limited to still images as argued by the Applicants. And furthermore, the subject matter "to keep a watermark sufficiently visible throughout a video sequence, wherein the image changes from frame to frame" is not claimed, as argued by the Applicants; and the subject matter "the optimal visibility of the transformed representation of the watermark is determined based on the transformed representation of the image" is not claimed in the claimed invention, as argued by the Applicants (see REMARKS page 4 lines 1-2), the subject matter as claimed in claim 1 recited "determining a transformed representation of the watermark for optimized visibility of the watermark in the image" and this claimed subject matter is clearly disclosed by Braudaway as pointed out in the rejection. Thus, Applicants argue limitations that are not in the claims. These arguments are not persuasive because the specification is not the measure of invention. Therefore, limitations contained therein can not be read into the claims for the purpose of avoiding

the prior art. See *In re Sporck*, 55 CCPA 743, 386 F.2d 924, 155 USPQ 687 (1968). Applicants' arguments regarding claim 4 are not persuasive, because, as pointed out above, Braudaway's system is not limited to still images as argued by the Applicants. Applicants' arguments regarding claims 2 and 3 are not persuasive, because no further arguments have been presented other than the arguments of the independent claim 1.

Allowable Subject Matter

6. Claim 5 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean W. Désir whose telephone number is (703) 308 9571. The examiner can normally be reached on 5/4/9 - First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on (703) 305 4795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JWD
Jan. 27, 05



JOHN MILLER
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TECHNOLOGY CENTER 2600